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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,376	01/23/2004	Fumio Ito	035576/273556	1703
K26	7590	04/25/2005	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			LEE, RIPA	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,376

Applicant(s)

ITO, FUMIO

Examiner

Rip A. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims 1, 2, 4, 5, 7, and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 2005/0001358 (Nakazawa *et al.*).

Nakazawa *et al.* teaches a polylactic acid composition comprised of polylactic acid polymer and 0.01-5.0 pw of a metal phosphate (claim 1). Claim 2 shows that the metal phosphate of formula (1) is essentially the same as that described in the instant claims. Table 1 shows use of aluminum *bis*(2,2'-methylene-4,6-di-*t*-butylphenyl)phosphate hydroxide. The composition further contains talc (Table 1 and paragraph [0118]). Example 1 shows that the composition is prepared by mixing and melt kneading in an extruder (crystallization temperature is 95 °C; the resulting pellets were used to make an injection molded product).

5. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2005/0001358 (Nakazawa *et al.*).

The discussion of the disclosures of the prior art from the previous paragraph of this office action is incorporated here by reference. The reference does not state specifically the form of the metal phosphate additive. However, one of ordinary skill in the art would have found it obvious that the material is "oriented" since the metal phosphate is crystalline and possesses oriented molecular structure. Furthermore, the publication is silent with respect to the properties of the polylactic acid product, as recited in the instant claims. However, a reasonable basis exists to believe that the material of Nakazawa *et al.* will exhibit the claimed features especially in view of the fact that it is essentially the same as that described in the instant claims. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an

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unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazawa *et al.* in view of U.S. 6,235,825 (Yoshida *et al.*).

Nakazawa *et al.* indicates that the polylactic acid composition may further comprise a lubricant or mold release agent or other nucleating agents, but the description of these compounds is not disclosed. Yoshida *et al.* teaches that fatty acid amides are suitable lubricants for polylactic acid compositions when used in the amount of 0.1-7.0 pw (col. 7, lines 3-37). One having ordinary skill in the art, then, would have found it obvious to use these lubricants because they are disclosed clearly in Yoshida *et al.* and the skilled artisan would have found it obvious to use it in the composition of Nakazawa *et al.* because the primary reference contemplates use of lubricants. The combination is obvious because both reference relate to manufacture of polylactic acid compositions.

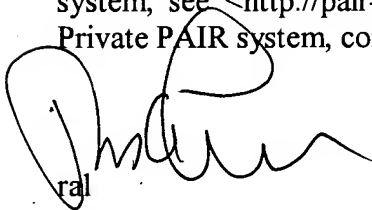
Information Disclosure Statement

7. The information disclosure statement fails to comply with 37 CFR 1.98(a)(1), which requires the application number of the application in which the information disclosure statement is being submitted on each page of the list. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



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February , 2005